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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,188	01/10/2001	Silvio Salom	ADC-501	2770

7590 01/12/2004
Aliko K. Collins
215 Grove St.
Newton, MA 02466

EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/759,188

Applicant(s)

SALOM, SILVIO

Examin r

Tan Dean Nguyen

Art Unit

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-- The MAILING DATE f this communication appears n the cover sheet with the correspondenc address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-19, 39-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-19, 39-40 are directed to "A method of generating a new enterprise", which is not within one of the classes of invention set forth in § 101.

The "method of generating a new enterprise" comprising the steps of (a) forming a holding company, (b) depositing at least one intellectual property assets, (c) evaluating and developing a 2nd application, and (d) deciding whether to form the new enterprise based on the developed 2nd application, as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "method of generating a new enterprise" comprising the steps of (a)-(d) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (inclusion of computer automation to carry out any functions) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172. Note that the term

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“data base” or “data bank” also means “any large or extensive collection of information” and does not have to be involved with a computer.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-19, 39-40, 20-38, 41-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claims 1 and 20 the steps for forming a new enterprise, especially with the last step of “deciding whether to form a new enterprise based on the developed 2nd application for the at least on IP asset” or “a new application development team for developing a 2nd application” is not clear, concise and full to enable any person skilled in the art to make and use the same steps to carry out the scope of the claimed invention which is “method and system for generating a new enterprise”. What are the tools or steps used to carry out this step or how one decides whether to form a new enterprise? In the specification, applicant further elaborate this step as shown on page 3, lines 15-20, i.e. “evaluating the ability of the new enterprise to generate \$500 million annual revenues within a 10 year period, or 1 billion market capitalization within 10 year period, and to generate positive cash flow” but fails to include steps or means of how to achieve the desired target or goal. An example in the

specification with steps or calculations of how to achieve the desired target would be sufficient to overcome the rejection.

5. Claims 1-19, 39-40, 20-38, 41-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite because the preamble clearly calls for “a Method of generating a new enterprise” but the last step of the claim with the limitation of “deciding whether to form” shows it is not clear that a new enterprise can be generated if it does not meet a certain requirement or if a decision is not made. In claim 1, it's not clear the relationship between the 1st application and 2nd application and how the decision to form a new enterprise is based on the 2nd application alone? What is the 1st application and it's role with respect to the step of generating a new enterprise?

Claim 20 is vague and indefinite because the preamble calls for “A business system for generating new enterprise” but there is no discussion or mentioning of “generating new enterprise” in the body of the claims. It's not clear the relationship between the “1st application, new application, and 2nd application” in relation to generating a new enterprise. It's not clear the relationship of the “a new application development team” with respect to the “holding company” or “existing enterprises”. Is the team part of the holding company or existing enterprises.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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7. Claims 1-19, 39-40, 20-38, 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over R1 (Pegasus article) in view of R2 (Financial Times, London) and R3 (SmartPatents).

R1 discloses a method a business system for forming a new created enterprise comprising the steps of a) forming a holding company comprising of previously existing enterprises, and managing intellectual property (IP) assets comprising key technologies within the existing enterprises (see abstract). R2 is cited to teach the importance of a making the most of IP assets for a successful corporations by managing IP assets, evaluating and developing application for the IP assets and forming a new enterprise based on the developed 2nd application for the IP assets (see page 1). R3 is cited to teach a system for assisting firms in protecting and optimizing use of IP for profitability by merging IP/patents with finance, sales, manufacturing, and management resources in order to license, trade, or sell IP/patents for profitability. It would have been obvious to modify the process of R1 by managing IP assets as taught by R2 and further using the provision of R3 to secure financing and provide management resources for the new enterprise.

As for claims 2, 10, 22, 30, these are taught in R3. As for claims 3-9, 19, 23-29, these are taught in R2 and R3. As for claim 11, the various financial parameters for forming a successful or profitable new enterprise are relative and depends on desired target and would have been to a skilled artisan. As for claim 21, this is taught in Article SmartPatents. As for claims 12, 31, these are fairly taught in R2 and R3 as they disclose the steps of devising commercial applications to be taken to the market through

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licensing or joint venture partners. As for claims 13, 32, these are inherently included in R1 since the partners are national corporations. Alternatively, it would have been obvious to form partners internationally to provide global service. As for claims 14, 33, these are inherently included in R1, R2 and R3 since they identifies, develops and acquires existing key technologies within the company and new technologies from outside the companies which occur frequently and/or on a repeatable basis. As for claims 15, 34, these are inherently included in R1/R2/R3 for a successful marketing and commercializing effort. As for claims 16-17, 35-36, since it's well known that many academic institution such as Stanford or MIT continuously provide academic researches has great potential commercial technologies, it would have been obvious to partner with the academic institutions to reap the benefits of obtaining new technologies. As for claims 18, 37, these are well known and obvious in the commercial business to encourage innovation by rewarding those who increase intellectual capital such as patents, new technology, etc. As for claims 19, 38, these are inherently included/obvious for supporting/maintaining a new/startup enterprise as are shown in R2 or R3. As for claims 39-40, 41-42, these are fairly taught in R1 in view of R2 and R3. Note that R1 involve the production of services such as cable, satellite TV or Internet services and Pegasus's IP rights also includes personalized media communications and the selection of any of the new service provided would have been obvious in view of the many services provided by Pegasus.

Response to Amendment

The amendment filed 9/15/03 has been entered.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Article "The only State Planning idea? Delaware Holding Company Concept" teaches the benefit of holding company.

Article "Aon Opens...Intellectual Property" discloses the importance of IP assets.

9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .

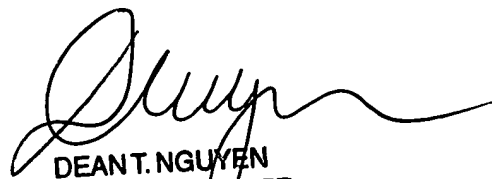
Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn
December 1, 2003


DEAN T. NGUYEN
PRIMARY EXAMINER